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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,294	09/16/2003	Tracy P. Roesler	3504	8402
27727	7590	12/13/2005	EXAMINER	
PEDERSEN & COMPANY, PLLC P.O. BOX 2666 BOISE, ID 83701			PIAZZA CORCORAN, GLADYS JOSEFINA	
			ART UNIT	PAPER NUMBER
			1733	
DATE MAILED: 12/13/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/667,294	Applicant(s) ROESLER ET AL.	
	Examiner Gladys JP Corcoran	Art Unit 1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/9/2004</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed February 9, 2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed.

a. The reference to the Information Disclosure Statement under 37 CFR Section 1.97, dated October 29, 2001 has been crossed out, and the information referred to therein has not been considered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 2 recites the limitation "said patch" in line 7. There is insufficient antecedent basis for this limitation in the claim. It is suggested to amend to --said cut vinyl patch--.

5. Claim 6 recites the limitation "said patch" in line 9. There is insufficient antecedent basis for this limitation in the claim. It is suggested to amend to --said cut patch--.

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6. Claim 9 recites the limitation "that damaged section" in line 7. The limitation is unclear as to what "that damaged section" is referring to, the prior recited "damaged floor covering section" or a second damaged section. It is suggested to amend to --the damaged section-- in order to comply with the original disclosure.

7. Claim 9 recites the limitation "the patch" in line 10. There is insufficient antecedent basis for this limitation in the claim. It is suggested to amend to --said cut patch--.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claim 2 is rejected under 35 U.S.C. 102(b) as being anticipated by the Admitted Prior Art.

The Admitted Prior Art discloses it is known in the floor vinyl repair art to provide a vinyl patch over a damaged vinyl section, cut through the vinyl patch and the damaged vinyl section, and replacing the damaged vinyl section with the cut patch (Specification pages 2 and 5). The Admitted Prior Art also discloses that Applicants have been performing the method of repair while doing work "for a living" (on sale) for more than one year prior to filing the patent Application by providing a spacing apparatus or spacer (one or more U.S. coins or tile fragments) between the damaged tile section and the tile patch to lift the center of the replacement tile slightly above the damaged tile (IDS filed February 9, 2004). Such lifting is considered to allow for a slight increase in a perimeter of the patch to offset the contraction of the patch after cutting.

12. Claims 1, 4, 5, 9-12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Admitted Prior Art as set forth above for claim 2.

As to claims 1 and 4, it is unclear whether the U.S. coins or tile fragments used by Applicant in the Admitted Prior Art have a central region thicker than edge regions. It is believed by the Examiner that all U.S. coins have raised portions in the central region that correspond to different decorations, typically a Head or Bust of a famous person on

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one side and a famous building or scenery on the other side. These decorative portions are all raised compared to the outer surrounding portions of the rest of coin. Therefore, the coins at least are considered to have central regions thicker than edge regions. If, by chance, the coins or tile fragments used by Applicant in the Admitted Prior Art did not have such thicker central regions, it would have been obvious to one of ordinary skill in the art at the time of the invention to use any available coin in the method of repair as shown by the Admitted Prior Art including coins with thicker central regions as described above, only the expected results would be attained.

As to claim 5, the Admitted Prior Art discloses that one or more U.S. coins or tile fragments were used as the spacers. It is unclear whether the multiple coins or fragments were used side by side or stacked in the Admitted Prior Art. If perhaps the multiple coins were not used stacked, such would have been well appreciated by one of ordinary skill in the art. One of ordinary skill in the art practicing the method as disclosed by the Admitted Prior Art would readily appreciate that stacking the coins or fragments would increase the height of the patch and thus increase the perimeter to compensate for contraction. Only the expected results would be attained.

As to claim 9, it is unclear whether the U.S. coins or tile fragments used by Applicant in the Admitted Prior Art had a protrusion on the bottom side. It is noted that the limitations of "for sticking into the damaged floor covering section to temporarily secure the spacing apparatus to the damaged floor covering section" is considered intended used and does not positively require the step of pushing the protrusion through the damaged floor covering section and temporarily secure the spacing apparatus to the

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damaged floor covering section. It is believed by the Examiner that all U.S. coins have protrusions on both surfaces (the raised decorative portions) and that there are many tile fragments which contain grooves and raised portions between the grooves on the bottom of the tile in order to hold the grout or adhesive for bonding the tiles to the floor. Therefore, the use of the coins, or if tiles with protrusions on the bottom were used, are considered to meet the claims. If, by chance, the coins or tile fragments used by Applicant in the Admitted Prior Art did not contain the protrusions on the bottom surface as discussed above, it would have been obvious to one of ordinary skill in the art at the time of the invention to use any available coin or tile fragment in the method of repair as shown by the Admitted Prior Art including coins and tile fragments with protrusions as described above, only the expected results would be attained.

As to claim 10, there are multiple U.S. coins with top surfaces that are domed shape (i.e. the shape of the raised portions which depict the heads of famous persons and those which depict the domed roofs of the buildings). And as discussed above, if such coins were not used, the use of such coins would have been obvious to one of ordinary skill in the art at the time of the invention.

As to claim 11, it is unclear whether the tile fragments used by Applicant had edges forming a square shape. Since most tiles come in a square shape, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a tile fragment of a square shape. Only the expected results would be attained.

Furthermore, one of ordinary skill in the art practicing the method as shown by the APA would readily recognize that there is no criticality to the particular shape of the edges of

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the spacer and it would have been well within the purview of one of ordinary skill in the art to use a spacer with square shaped edges, only the expected results would be attained.

As to claim 12, see discussion above for claim 5.

Allowable Subject Matter

13. Absent any additional pertinent prior art, Claim 3 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

14. Absent any additional pertinent prior art, Claims 6-8 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

15. The following is a statement of reasons for the indication of allowable subject matter:


As to claims 3 and 6, while it is known in the Admitted Prior Art to provide spacers of U.S. coins and tile fragments between damaged vinyl sections and a vinyl patch in a method of repairing floor vinyl, there is no suggestion to provide a spacer that is shaped like a domed-disc as set forth in the claim and in the claimed environment.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gladys JP Corcoran whose telephone number is (571) 272-1214. The examiner can normally be reached on M-F 8am-5:30pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gladys JP Corcoran
Primary Examiner
Art Unit 1733

GJPC